

64 wherein the prizes include cash prizes and non-cash prizes and wherein at least one gaming machine is operable for each played game of chance on the at least one gaming machine to: 1) receive a selection of a prize from the list of prizes prior to determining the outcome of the played game of chance wherein the prize corresponds to an award for at least one outcome for the played game of chance and wherein the prize is only awarded after the outcome of the played game of chance is determined, 2) determine the outcome for the played game of chance 3) display the outcome for the played game of chance and 4) indicate an award of the prize when the determined outcome for the played game of chance is the same as the at least one outcome for the played game of chance corresponding to the prize.

REMARKS

Claims 1-44 are currently pending in the application. Claims 1, 21, 24 and 35 have been amended. The applicant believes the claim amendments do not add any new matter. Claims 14-20 have been cancelled.

Drawings

The examiner objected to the drawings because they to show gaming machine comprising a master gaming controller as described in the specification. Figure 4 has been corrected to show a master gaming controller, which is described in the specification with respect to Figure 4. A proposed drawing correction for FIG. 4 has been submitted with the amendment.

Specification

Claim 1 has been amended, the specification has been amended and a proposed drawing correction has been submitted and the objection to the specification is believed overcome thereby.

Rejections under 35 U.S.C. § 112

The examiner rejected to claims 14-20 under 35 U.S.C. § 112. Claims 14-20 have been canceled.

Rejections under 35 U.S.C. § 102

The Examiner rejected claims 1-2, 4, 6-25, 27-30 and 32-44 under 35 USC 102(e) as being clearly anticipated by Kelly (US patent No. 6015344). The rejections are respectively traversed.

Kelly describes a system providing redemption games. In a redemption game, a player earns tickets or some other medium of exchange that can be used to obtain the offered prizes which are defined as merchandise, souvenir, food item or other physical goods or services. The redemption tickets are not considered a prize as defined by Kelly (Col. 9, 1. 60-Col. 10, 1. 29). In Kelly, a player can obtain prizes in two ways: 1) either by accumulating enough tickets or 2) via an instant win. The amount of universal tickets dispensed to the player is typically based upon a game score or other result of a game process. The tickets are used as a medium of conversion from game score to prize value (Col. 10, 1. 30-36). The more valuable the prize, the greater number of tickets required to redeem the prize (Col. 10, 1. 15-17). After accumulating tickets, a prize selection unit can be used to redeem prizes. A prize selection menu provides a list of prizes and also includes a prize cost or value for each displayed prize. A player can select any of the prizes for which he or she has enough prize credits (Col. 29, 1. 39-51). The prizes that a player can select are determined by the operator of the game unit (See FIG. 9).

An "instant prize" (or "specific prize") can also be won where the player can receive the prize due to a particular winning result on the game unit (Col. 10, 1. 54-57). The player does not have to accumulate tickets to win the specific prize (Col. 11, 1. 39-45). ***In Kelly, the player does not have a choice in regards to what instant prize may be won due to a particular winning result.*** In FIG. 9 in Kelly, it is clearly described that the operator selects and sets the instant prizes that are available on the game unit in an operation that is outside of normal game play. During game play, a player can select a prize for redemption after they have accumulated enough redemption tickets required for the prize or the player can win an instant prize. However, Kelly does not describe a player being able to select a instant prize that they can receive due to a particular winning result where the prize and winning result are associated with a particular game played on the gaming machine.

In contrast, the present invention, as described in claims 1, 21 24 and 35, recites a gaming machine that is operable for each played game of chance to: "1) receive a selection of a prize from a list of prizes prior to determining the outcome of the played game of chance wherein the prize corresponds to an award for at least one outcome for the played game of chance and wherein the prize is only awarded after the outcome of the played game of chance is determined, 2) determine the outcome for the played game of chance 3) display the outcome for the played game of chance and 4) indicate an award of the prize when the determined outcome for the played game of chance is the same as the at least one outcome for the played game of chance corresponding to the prize." In Kelly, an instant prize can be awarded where the player does not have to accumulate tickets to win the prize. In Kelly, a player can select a prize for redemption when they have accumulated enough tickets. However, in Kelly, for each game of chance played on the gaming machine, the player is not allowed to select an instant or specific prize prior to playing the game of chance that can be won instantly as a result of playing a particular

game of chance on the game unit for which the prize was selected. Prizes that can be won instantly are only selected by the operator outside of normal game play on the game unit.

In Kelly, during a series of games where a player has accumulated enough tickets to redeem a prize, a player can select a prize for redemption and then initiate a new game. However, the prize selected for redemption is awarded prior to the play of new game and in particular prior to determining the outcome of the new game. If the player does not have enough tickets for a particular prize, then the prize can't be selected for redemption. An instant prize can be awarded after the play of the new game but this prize can't be selected by the player prior to determining the outcome for the new game. Therefore, Kelly can't be said to anticipate claims 1-2, 4, 6-13, and withdrawal of the rejections is respectfully requested. Using similar reasoning for claims 14-25, 27-30 and 32-44, (claims 14-25, 27-30 and 32-44 have limitations similar to claim 1, Kelly can't be said to anticipate these claims and withdrawal of the rejections is respectfully requested.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1-44 U.S.C. 103 (a) as being unpatentable over Walker et al. (6,068,552) in view of Kelly (US patent No. 6015344). The rejection is respectfully traversed.

In Walker, a gaming machine is described where the player may customize the odds, pay-out schedule and wager amounts and the gaming machine automatically determines changes in other parameters which were not customized to maintain a constant house advantage (Abstract). The player may customize a "cash" pay schedule which is amount paid for each real combination shown, based on an amount wagered (Col. 4, 1. 43-55). The player's preferences for customizing the gaming machine can be stored on the slot server and retrieved by the player identifier when the player inserts a player-tracking card into the machine (Col. 11, 1. 14-20). In Walker, the figures do not show or suggest any non-cash prizes of any kind which may be awarded to a player in response to a game outcome generated on the gaming machine and the specification does not describe suggest any non-cash prizes and methods of awarding non-cash prizes in any manner. For instance, FIGs. 2, 3, 4A, 4B, 5, 6, 8, 10, 11A, 11B and 12 all show amounts of credits that are awarded based on the game outcome generated on the gaming machine. The credits have a cash-value based on the amount wagered and can be used for additional game play or cashed out by the player. ***In Walker, the prize available is always cash, the player has no choice in regards to what prize is awarded.***

In contrast, all of the claims of the present invention describes provisions for a gaming machine that is operable for each played game of chance to: "1) receive a selection of a prize from a list of prizes prior to determining the outcome of the played game of chance wherein the prize corresponds to an award for at least one outcome for the played game of chance and wherein the prize is only awarded after the outcome of the played game of chance is determined,

2) determine the outcome for the played game of chance 3) display the outcome for the played game of chance and 4) indicate an award of the prize when the determined outcome for the played game of chance is the same as the at least one outcome for the played game of chance corresponding to the prize.” The prizes that may be selected include “cash prizes and non-cash prizes.” In Kelly, for each game of chance played on the gaming machine, the player is not allowed to select an instant prize or specific prize non-cash prior to playing the playing a game of chance that can be won instantly as a result of playing the game of chance on the game unit. The Walker reference describes a gaming device where a user may select different cash payouts as an outcome for a game generated on the gaming device where a constant house advantage is maintained. In Walker, the only prize that a player may choose is cash. The player may adjust their of their odds of winning the cash but can’t select among different types of prizes such as between cash and non-cash prizes or between different types of non-cash prizes. Thus, Walker teaches odds selection not prize selection.

In regards, to the combination of Walker and Kelly, neither reference provides motivation for the modification suggested by the Examiner. Walker teaches odds selection not prize selection. In Walker, there is no teaching or suggestion of providing non-cash prizes or any discussion of non-cash prizes. In Kelly, the redemption of prizes is described where a player selects a prize to be exchanged for a number of prize tickets earned by the player. The winning of an instant prize is described where the player can win the instant prize directly without accumulating tickets. Depending on the results of a particular game the player has engaged in on the game unit, the instant prize may be awarded. Kelly teaches that the selection of the instant prizes are performed by the operator in an operation outside of game play on the gaming unit. In Kelly, during game play, the player is not provided the opportunity to select a prize that then can be won immediately depending on the results of a particular game the player has played just after the prize selection. Further, Kelly does not teach or suggest a game machine where the player selects an prize that then can be won immediately depending on the results of a particular game the player has played just after the prize selection. Therefore, Kelly, Walker or the combination of Kelly and Walker can’t be said to render obvious the invention as recited in claims 1-44 and the objection is believed overcome thereby.

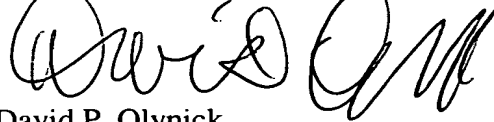
The Examiner rejected claims 3, 5, 26 and 31 under U.S.C. 103 (a) as being unpatentable over Kelly (US patent No. 6015344) in view of Walker et al. (6,068,552). The rejection is respectfully traversed

As described above, Kelly or Walker don’t teach a gaming machine where for each game played the player can select a non-cash prize prior to playing the game that then can be won immediately depending only on the results of a particular game the player has played just after the prize selection. Further, as described above, Kelly and Walker do not provide motivation for the combination of Kelly and Walker suggested by the examiner. For at least these reasons described above, it is respectfully submitted the Walker references can’t be said to render

obvious the invention as recited in Claims 3, 5, 26 and 31 and withdrawal of the rejection is respectfully requested.

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP

A handwritten signature in black ink, appearing to read "David P. Olynick", written over the printed name.

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APPENDIX A

At page 16, last paragraph which extends to page 17, please substitute the following paragraph.

In an alternative embodiment of the present invention, a player has direct access to terminal 403, which may be configured as a "prize kiosk." The prize groups may be viewed by the player on a touch screen 412. Also, the prizes could be viewed on a video display screen without touch screen capabilities. The different prizes presented are viewed, searched and selected using the touch screen 412, prize selection inputs 425 or combinations of both the touch screen and the prize selection inputs. When a player has chosen one or more prizes or combinations of prizes, the prize information may be stored on a magnetic card or smart card inserted into the card reader 415 or a printed prize sheet from the printer 423. Other output mechanisms may be used to output prize information to a storage device including an optical card reader, a smart card reader, a personal digital assistant or a mechanism for electronically transferring data to a player's pre-existing account such as a connection to remote account server. To play for one or more of the selected prizes, a player inserts the magnetic card or smart card containing the prize information into the card reader 420 on the gaming machine 400 or inputs prize information into the gaming machine using the prize selection inputs 426. The prize information containing the selected prizes might be read and displayed on the display screen 422 or some other display device on the gaming machine. When the player initiates a game, the gaming machine selects the appropriate pay table for the prize or prizes selected and presents a game outcome to the player in the display area 418. The pay tables corresponding to different prizes and may be stored in a memory location 424 residing within the gaming machine 400. [The]This may also be configured on a master gaming controller 401 of the gaming machine 400. When a specific outcome of a game occurs corresponding to a pay-out of the selected prize, the player wins the selected prize. An advantage of acquiring prize information on a terminal separate from the gaming machine is that a large number of prizes may be searched without using valuable game playing time searching for a gaming machine having the prizes desired by a player.

At page 17, first full paragraph, please substitute the following paragraph.

In another embodiment of the present invention, a player selects prizes from a display terminal connected directly to the gaming machine. For example, prizes available for selection might be displayed on the display screen 422 located within the top box 419 or on the display screen 418 located on the main cabinet of the gaming machine 400. A list of available prizes or prize groups might be obtained from the prize server 402 which may be located within the

gaming machine 400 or may be physically separate from the gaming machine. After initiating a game by inputting a wager into the gaming machine 400, a player might pre-select a prize from the list of prizes available and begin game play. As described above, when a game play is initiated by the player, the gaming machine selects the appropriate pay table for the prize or prizes selected and presents a game outcome to the player in the display area 418. As mentioned, the pay tables corresponding to different prizes and may be stored in a memory 424 or configured on the master gaming controller 401 of gaming machine 400. When a specific outcome of a game occurs corresponding to a pay-out of the selected prize, the player wins the selected prize.

APPENDIX B

1. (Three Times Amended) A gaming machine comprising:
a master gaming controller designed or configured to control [a game play sequence on the gaming machine for a game of chance, said game play sequence comprising:] a game of chance played on the gaming machine wherein the gaming machine is operable for each played game of chance to:
 - [1) receiving a wager on an outcome for the game of chance,
 - 2) receiving a prize selection corresponding to an award for at least one outcome for the game of chance,]
1) receive a selection of a prize from a list of prizes prior to determining the outcome of the played game of chance wherein the prize corresponds to an award for at least one outcome for the played game of chance and wherein the prize is only awarded after the outcome of the played game of chance is determined,
 - [3) determining]2) determine the outcome for the played game of chance,
 - [4) displaying]3) display the outcome for the played game of chance and
 - [5) awarding the selected prize when the determined outcome for the game of chance and the outcome for the game of chance corresponding to the prize selection are the same;] 4) indicate an award of the prize when the determined outcome for the played game of chance is the same as the at least one outcome for the played game of chance corresponding to the prize;
a memory for storing [a]the list of prizes;
a prize display mechanism displaying the prizes stored in the memory; and
a prize selection mechanism used to select one or more prizes corresponding to one or more outcomes of the game of chance played on the gaming machine
wherein the prizes include cash prizes and non-cash prizes.
2. (Amended) The gaming machine of claim 1, wherein the non-cash prizes are selected from the group consisting of merchandise, vacations, airline miles, and shopping sprees.
3. (Amended) The gaming machine of claim 1, wherein the prize selection mechanism allows the user to select one or more prizes specific to a wager amount of the game of chance played on the gaming machine.
4. The gaming machine of claim 1, wherein the gaming machine is a mechanical slot machine, a video slot machine, a keno game, a lottery game, or a video poker game.

5. (Amended) The gaming machine of claim 1, wherein a probability of the outcome of the game of chance played on the gaming machine is specific to a value of the selected prize.

6. The gaming machine of claim 1, wherein the prize selection mechanism is a key pad, a button panel, a video touch screen, a mouse, a touch pad, a joystick, a microphone or a magnetic card.

7. (Amended) The gaming machine of claim 1, wherein the prize display mechanism is a printed sign, a video display screen, a bonus wheel, a video touch screen, an LCD (Liquid Crystal Display), a back-lit glass panel or a prize.

8. (Amended) The gaming machine of claim 1, wherein the memory is an EEPROM (Electrically Erasable Programmable-Read only Memory), a CD-ROM (Compact Disc-Read Only Memory), DVD (Digital Versatile Disc), a non-volatile memory, or a magnetic storage device.

9. The gaming machine of claim 1, wherein the gaming machine provides a display format for the one or more prizes displayed on the display mechanism.

10. The gaming machine of claim 9, wherein the display format is graphical or textual.

11. The gaming machine of claim 9, wherein the display format indicates a feature of the prize.

12. The gaming machine of claim 11, wherein the prize feature is a prize value.

13. The gaming machine of claim 11 wherein the prize feature is a prize theme.

14.-20. Cancelled.

21. (Three times Amended) A prize distribution network comprising:

(a) a prize server comprising;

an interface for providing prize information to one or more gaming machines wherein at least one of the gaming machines is external to the prize server; and

a memory storing the prize information as groups of prizes for separate display on the one or more gaming machines; and

(b) a plurality of gaming machines each gaming machine comprising;

a memory storing a list of prizes; and

a prize display mechanism displaying the prizes; and

a prize selection mechanism [used to select]for selecting one or more prizes for one or more outcomes of a game of chance played on the gaming machine wherein the prizes include cash prizes and non-cash prizes and wherein at least one gaming machine of the plurality of gaming machines is operable [to receive a wager on an outcome for a game of chance, to receive a prize selection corresponding to an award for at least one outcome for the game of chance, to determine the outcome for the game of chance, to display the outcome for the game of chance and to award the selected prize when the determined outcome for the game of chance and the outcome for the game of chance corresponding to the prize selection are the same] for each played game of chance on the at least one gaming machine to: 1) receive a selection of a prize from the list of prizes prior to determining the outcome of the played game of chance wherein the prize corresponds to an award for at least one outcome for the played game of chance and wherein the prize is only awarded after the outcome of the played game of chance is determined, 2) determine the outcome for the played game of chance 3) display the outcome for the played game of chance and 4) indicate an award of the prize when the determined outcome for the played game of chance is the same as the at least one outcome for the played game of chance corresponding to the prize.

22. (Amended)The prize distribution network of claim 21, wherein the game of chance is selected from the group consisting of a slot game, a keno game, a lottery game, or a poker game.

23. (Amended) The prize distribution network of claim 21, wherein the non-cash prizes are selected from the group consisting of merchandise, vacations, airline miles, and shopping sprees.

24. (Twice Amended) In a gaming machine having a prize selection mechanism, a prize display mechanism for displaying a list of prizes, a method of selecting a prize specific to an outcome of a game of chance played on a gaming machine, the method comprising;
displaying multiple prizes available for selection [in]on the prize display mechanism;

receiving an input signal from the prize selection mechanism for selecting a prize from the list of prizes prior to determining the outcome of the game of chance, said input signal corresponding to a user's selection of the selected prize wherein the selected prize corresponds to an award for one of the outcomes of the game of chance and wherein the prize is only awarded after the outcome of the played game of chance is determined;

receiving a wager for the game of chance;

determining the outcome for the game of chance;

presenting the outcome for the game of chance; and

indicating an [awarding] award of the selected prize when the determined outcome for the game of chance [and] is the same as the one the outcomes of [outcome for] the game of chance corresponding to the prize selection [are the same]

wherein the prizes include cash prizes and non-cash prizes.

25. (Amended) The method of claim 24, wherein the non-cash prizes are selected from the group consisting of merchandise, vacations, airline miles, and shopping sprees.

26. (Amended) The method of claim 24, further comprising determining a pay table to be used in determining the outcome for the game of chance, wherein the pay table is chosen according to the value of the selected prize.

27. The method of claim 24, further comprising outputting the selected prizes to a portable memory device.

28. (Amended) The method of claim 27, wherein the portable memory device is a magnetic card, a personal digital assistant or a smart card.

29. The method of claim 24, wherein the prize selection mechanism is a key pad, a button panel, a touch screen, a mouse, touch pad, joystick, a microphone, a smart card or a magnetic card.

30. (Amended) The method of claim 24, further comprising receiving a signal for initiating the game of chance.

31. (Amended) The method of claim 24, further comprising displaying a group of prizes available for selection in the prize display mechanism specific to a wager amount.

32. (Amended) The method of claim 24, wherein the game of chance is a slot game, a keno game, a lottery game, or a poker game.

33. The method of claim 24, further comprising displaying the selected prize on the prize display mechanism.

34. (Amended) The method of claim 24, wherein the prize display mechanism is a printed sign, a video display screen, a bonus wheel, a video touch screen, back-lit glass panel or an LCD (Liquid Crystal Display).

35. (Three Times Amended) In a prize distribution network comprising a plurality of gaming machines connected to a prize server, a method for distributing information about prizes available on specific gaming machines, the method comprising,

establishing communication with each gaming machine connected to the prize server; and

sending prize information from a memory on the prize server to a memory on each gaming machine, said prize information specific to prizes which are available for selection by game players as game awards on games played on the gaming machines

wherein the prizes include cash prizes and non-cash prizes and wherein at least one gaming machine is operable [to receive a wager on an outcome for a game of chance, to receive a prize selection corresponding to an award for at least one outcome for the game of chance, to determine the outcome for the game of chance, to display the outcome for the game of chance and to award the selected prize when the determined outcome for the game of chance and the outcome for the game of chance corresponding to the prize selection are the same] for each played game of chance on the at least one gaming machine to: 1) receive a selection of a prize from the list of prizes prior to determining the outcome of the played game of chance wherein the prize corresponds to an award for at least one outcome for the played game of chance and wherein the prize is only awarded after the outcome of the played game of chance is determined, 2) determine the outcome for the played game of chance 3) display the outcome for the played game of chance and 4) indicate an award of the prize when the determined outcome for the played game of chance is the same as the at least one outcome for the played game of chance corresponding to the prize.

36. (Amended)The method of claim 35, wherein the game of chance is a slot game, a keno game, a lottery game, or a poker game.

37. (Amended) The method of claim 35, wherein the prizes are selected from the group consisting of merchandise, vacations, airline miles and shopping sprees.

38. The method of claim 35, further comprising displaying the prize information to a video display screen associated with one or more of the gaming machines.

39. The method of claim 38, further comprising identifying one or more prizes selected by a user.

40. The method of claim 39, further comprising outputting the selected prize information to a portable storage device, which can be read by one or more of the gaming machines.

41. The method of claim 24, further comprising:
printing a record of the selected prizes.

42. The prize server of claim 14, wherein the prize server is a gaming machine.

43. The prize server of claim 14, wherein the prize server is configured to receive prize fulfillment information used to redeem prizes won by players playing the gaming machines.

44. The prize distribution network of claim 21, further comprising:
a prize fulfillment center that is used to acquire and deliver prizes.